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In re Application of :
Contini et al. :
Application No. 10/809,333 : **ON PETITION**
Filed: March 26, 2004 :
Attorney Docket No. CON003-108 :

This is a decision on the petition under 37 CFR 1.137(b), filed December 15, 2006, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency decision within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned in response to the petition under 37 CFR 1.138(c) filed November 1, 2006, requesting express abandonment of the above-identified application. The express abandonment was recognized on November 1, 2006. Accordingly, the above-identified application became abandoned on November 1, 2006.

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply, unless previously filed;
 - (2) the petition fee as set forth in 37 CFR 1.17(m);
 - (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and
 - (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d).
- Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

This petition lacks item (3). The showing of record raises questions as to whether the abandonment of this application was unintentional within the meaning of 35 USC 41(a)(7) and 37 CFR 1.137(b).

Petitioner asserts that "a representative for the Applicant filing a Request for Express Abandonment in the wrong case."

MPEP 711.01 states:

The applicant (acquiesced in by an assignee of record), or the attorney/agent of record, if any, can sign an express abandonment. It is imperative that the attorney or agent of record exercise every precaution in ascertaining that the abandonment of the application is in accordance with the desires and best interests of the applicant prior to signing a letter of express abandonment of a patent application. Moreover, special care should be taken to ensure that the appropriate application is correctly identified in the letter of abandonment.

A thorough review of USPTO records shows that: (1) petitioner filed in the above-identified application, on November 1, 2006, a petition for express abandonment under 37 CFR 1.138(c) and (2) the Office recognized the express abandonment in the above-identified application on November 1, 2006.

Initially it is noted that petitioner was notified by the Office of the abandoned status of this application on November 1, 2006, no petition to revive this application was filed until December 15, 2006. That is, while petitioner may not have been aware of the abandoned status of this application until a recent file audit, they were notified of the abandoned status of this application on November 1, 2006.

Petitioner has filed no evidence, which would lead one to reasonably believe that this application was unintentionally abandoned. In this regard, petitioner has failed to submit any evidence of the circumstances surrounding the abandonment of this application. For example, no specific explanation has been given as to how and why a miscommunication regarding this application occurred.

35 U.S.C. § 41(a)(7) applies to the situation of the above-identified application (i.e., to the revival of an abandoned application), however, it precludes the Director from reviving the above-identified application. This is because § 41(a)(7) only authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of \$500 or a fee of \$50 would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), reprinted in 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application, as this application was, is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Commissioner to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where there is a question whether the delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989). Here, in view of Express Abandonment of record, there is a question whether the entire delay was unintentional.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
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 Alexandria, VA 22313-1450

By hand: Customer Service Window
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 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (571) 273-8300
 ATTN: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3206.


Liana Walsh
Petitions Examiner
Office of Petitions